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EXAMINER

COLON, CATHERINE M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3623

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/746,611

Applicant(s)

PERRY ET AL.

Examiner

C. Michelle Colon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on August 25, 2003. Claims 1-18, 20-22, 25, 27, 30-32, 36 and 37 have been amended. Claims 1-38 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's amendments to claims 1-18, 20-22, 25, 27, 30-32, 36 and 37 are acknowledged. The amendments overcome the 35 U.S.C. 112, second paragraph rejection to claim 10 of paper no. 8. Therefore, the 35 U.S.C. 112, second paragraph rejection is withdrawn.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered, but are found unpersuasive. In the Remarks, Applicant argues that Ruffin does not disclose or suggest any method or system for evaluating a business proposal where the proposal is something other than a proposed sale of an IT system, where, in contrast, the claimed invention recites proposals that are for alliances, acquisitions, partnerships, or ventures.

In response to the argument, Examiner respectfully disagrees and further asserts that the argument is irrelevant since no where in the claims is it expressly recited that the proposal has to be something other than an IT solution. Those features upon which applicant relies (the proposal being something other than a proposed sale of an IT system) are not recited in the rejected claim(s). Although the claims are interpreted in

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light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Applicant's argument is based on the assumption that providing an IT solution cannot be the same as a business relationship such as an alliance, acquisition, partnership or venture. Business relationships, such as the ones claimed and listed above, have long relied on the mutual benefit gained by all parties in exploiting each other's expertise and/or resources, including information technology. Thus, that Ruffin's embodiment is for IT solutions is irrelevant. Lastly, in col. 3, lines 19-35 and col. 6, lines 1-6, Ruffin discloses the invention can be applied to any type of business solution, which may or may not include information technology.

Accordingly, Applicant's arguments have been fully considered, but are found unpersuasive.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Ruffin (U.S. 6,219,654).

As per claim 1, Ruffin discloses a method of evaluating a business proposal, comprising the steps of:

gathering information on the proposal, wherein the information comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal, and wherein the proposal is an alliance, an acquisition, an equity venture, a partnership, or a venture (col. 2, lines 29-33; col. 3, line 10-col. 4, line 12; The reference discloses gathering information from customers to assess their IT needs for a proposal for an IT solution, which can be an alliance, partnership or venture. Businesses often form ventures, alliances or partnerships in order to gain access to expertise/resources they are currently lacking.);

accessing information on similar or analogous proposals (col. 4, lines 41-48; col. 7, lines 15-25; The reference discloses accessing information in a database of customers with similar requirements and needs.);

evaluating the information by computer (col. 3, lines 38-64; col. 8, lines 3-60; The reference discloses a computer program tool and database for evaluating customers' business needs and generating proposals.); and

ranking the proposals (col. 16, lines 1-24; Figure 9; The solutions are ranked according to how closely they apply to the customer's ranked objectives.).

As per claim 2, Ruffin discloses the method of claim 1, wherein information gathered further comprises at least one of business environmental information, business issues and goals, financial information, and methods of achievement of the

proposal (col. 8, lines 10-16; col. 9, lines 26-29; col. 10, lines 10-24; col. 13, lines 39-67; Figure 5; The reference discloses collecting customer's financial data as well as information regarding their IT environment.).

As per claim 3, Ruffin discloses the method of claim 1, wherein the information gathering step further comprises answering predetermined questions on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 49-67; col. 8, line 61-col. 9, line 20; col. 9, lines 51-67; Figure 4).

As per claim 4, Ruffin discloses the method of claim 1, wherein the proposals are evaluated by calculating at least one of a cost, a revenue stream, a return on average assets, a return on investment, a return on equity, and internal rate of return, and a net present value (col. 17, line 44-col. 18, line 62; Figures 9 and 10; The IT solutions are evaluated by comparing how closely they address the customer's goals and objectives, which includes an evaluation of cost.).

As per claim 5, Ruffin discloses the method of claim 1, further comprising evaluating risks of the proposal as high or normal (col. 16, lines 19-53).

As per claim 6, Ruffin discloses the method of claim 1, further comprising gathering information on a customer for the proposal, agents of the customer or employees of the customer (col. 2, lines 29-38; col. 3, lines 1-34).

As per claim 7, Ruffin discloses the method of claim 1, further comprising displaying the rankings with a graphical user interface (col. 16, lines 1-24; Figure 9; The rankings can be displayed in a tabular form.).

As per claim 8, Ruffin discloses the method of claim 6, wherein information concerning the experience of the provider in providing the service is available in at least one database (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 9, Ruffin discloses the method of claim 1, wherein information concerning the benefits of the proposal is available in at least one database (col. 10, lines 25-34; col. 14, lines 58-67; Figures 4 and 5).

As per claim 10, Ruffin discloses the method of claim 1, wherein the cost of the proposal is calculated as a revenue stream to a service provider (col. 6, lines 47-54).

As per claim 11, Ruffin discloses the method of claim 10, further comprising the steps of calculating a benefit to the customer of providing said service to said customer (col. 9, lines 34-41; col. 10, lines 25-34; col. 12, lines 21-25; The reference discloses calculating whether a customer would benefit from the service of the service provider.).

As per claim 12, Ruffin discloses the method of claim 1, further comprising assessing the proposal in light of present business considerations, risks of the proposal, or financial considerations of the proposal (col. 9, lines 21-41; col. 10, lines 10-34; col. 12, lines 21-33; The reference discloses assessing the proposal in light of the customer's present business considerations such as risks and financial matters.).

As per claim 13, Ruffin discloses the method of claim 1, wherein at least some of the information is gathered through the Internet, and further comprising the steps of

updating the information and reevaluating the information (col. 7, lines 26-65; col. 9, lines 34-50; The reference discloses conducting Internet surveys to gather customer information and further updating the customer profile.).

As per claim 14, Ruffin discloses the method of claim 1, wherein the proposal comprises an offer of a service from a provider, and further comprising the step of calculating a way to pay for the proposal (col. 2, lines 29-33; col. 5, line 62-col. 6, line 11; col. 7, lines 6-40; col. 8, lines 3-20; col. 17, lines 44-52; col. 18, lines 40-62; The reference discloses offering IT services to customers as well as cost analyses in a proposal.).

As per claim 15, Ruffin discloses the method of claim 1, wherein the proposals are ranked by displaying at least one of a numerical ranking or a pseudo-numerical output (col. 16, lines 1-24; Figure 9; The solutions are ranked by scores.).

As per claim 16, Ruffin discloses the method of claim 1, wherein the information is provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 17, Ruffin discloses the method of claim 1, wherein an output is provided through a graphical user interface, and the output is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 18, Ruffin discloses a method of evaluating a business proposal, comprising:

searching at least one database for information concerning a business partner, the proposal and a business environment, wherein the information includes cost drivers,



revenue drivers, markets served, risks of the proposal, customers served, and a competitive advantage (col. 7, lines 15-25; col. 8, lines 48-60; Figure 2; Databases are searched for previous solutions offered to customers that meet certain business and financial criteria.);

providing financial data concerning the proposal to a computer, wherein the financial data includes revenue elements of the proposal, a cost of the proposal, and an innovation value of the proposal (col. 4, lines 49-67; col. 8, lines 11-17; col. 18, lines 9-53);

proposing at least one structure for the business proposal, using said financial data and information from the database, wherein the structure is an alliance, an acquisition, an equity venture, a partnership, or a venture (col. 2, lines 29-33; col. 3, line 10-col. 4, line 12; The reference discloses proposing IT solutions for customers, which can be alliances, partnerships or ventures. Businesses often form ventures, alliances or partnerships in order to gain access to expertise/resources they are currently lacking, such as information technology.); and

calculating an advantage of the business proposal (col. 10, lines 25-38).

As per claim 19, Ruffin discloses the method of claim 18, wherein the database comprises a client relationship repository of information (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 20, Ruffin discloses the method of claim 18, further comprising evaluating risks of the proposal as high or as normal (col. 16, lines 19-53).

As per claim 21, Ruffin discloses the method of claim 18, wherein the step of providing financial data comprises retrieving financial data from at least one database (col. 4, lines 49-61; col. 8, lines 10-17; col. 18, lines 9-20; The reference discloses using financial tools to assess solutions/proposals provided to a customer.).

As per claim 22, Ruffin discloses the method of claim 18, further comprising the step of entering information concerning at least one of risks, descriptive information, business environment, business issues, business goals, a value of the proposal, and methods of achievement of the proposal, for use by a computer in determining the advantage of the proposal (col. 2, lines 29-33; col. 3, lines 53-64).

As per claim 23, Ruffin discloses the method of claim 22, wherein the information is entered through at least one template stored in a computer (col. 4, lines 13-17 and 41-61; The reference discloses gathering information from a customer via a profile template.).

As per claim 24, Ruffin discloses the method of claim 23, wherein the information entered through at least one template calls up at least one template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses that customers' answers to the predetermined questions can be used to call up additional templates such as financial, work assessment and planning tools.).

As per claim 25, Ruffin discloses the method of claim 18, wherein the advantage is calculated as at least one of a cost, a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present

value (col. 17, line 44-col. 18, line 62; Figures 9 and 10; The IT solutions are evaluated by comparing how closely they address the customer's goals and objectives, which includes an evaluation of cost.).

As per claim 26, Ruffin discloses the method of claim 18, wherein the advantage is calculated as at least one revenue stream and includes an example of how to pay for the service (col. 2, lines 29-33; col. 5, line 62-col. 6, line 11; col. 7, lines 6-40; col. 8, lines 3-20; col. 17, lines 44-52; col. 18, lines 40-62; The reference discloses offering IT services to customers as well as cost analyses in a proposal.).

As per claim 27, Ruffin discloses the method of claim 18, wherein more than one proposal or structure is proposed, and further comprising the step of ranking each proposal or structure (col. 16, lines 1-53; Figure 9; The system ranks and compares more than one possible IT solutions for customers.).

As per claim 28, Ruffin discloses the method of claim 18, wherein the advantage is recalculated by a step of entering updated data into the computer (col. 18, lines 21-62).

As per claim 29, Ruffin discloses the method of claim 18, wherein the step of searching comprises a search of at least one Internet site, and further comprising the steps of updating the search periodically, and updating the computer calculation of an advantage periodically (col. 3, lines 38-64; col. 8, line 48-col. 9, line 66; The reference discloses providing customers the ability to interact with the BSA tool through a graphical interface over the Internet. When users enter information into the tool, the corresponding databases of information are updated.).

As per claim 30, Ruffin discloses the method of claim 18, wherein the information is provided through a graphical user interface, and the output is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 31, Ruffin discloses the method of claim 18, further comprising a step of providing an output through a graphical user interface, wherein the output is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 32, Ruffin discloses a computer system for evaluating a proposal, comprising:

a computer processor (Figure 3);

at least one memory operably connected to said computer, said memory containing data relevant to the proposal, wherein the data comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal (col. 2, lines 29-33; col. 3, line 10-col. 4, line 12; The reference discloses gathering information from customers to assess their IT needs for a proposal for an IT solution.); and

a computer program for evaluating the proposal, said program residing in said computer or in said memory, wherein the proposal is an alliance, an acquisition, an equity venture, a partnership, or a venture, and computer program calculates an output helpful for evaluating the proposal (col. 3, lines 38-64; col. 8, lines 3-60; The reference discloses a computer program tool and database for evaluating customers' business

needs and generating proposals. Businesses often form ventures, alliances or partnerships in order to gain access to expertise/resources they are currently lacking such as information technology.).

As per claim 33, Ruffin discloses the computer system of claim 32, wherein the proposal is from a provider of goods or services to a customer (col. 2, lines 29-38; col. 3, lines 1-7; col. 6, lines 65-67).

As per claim 34, Ruffin discloses the computer system of claim 32, wherein the data comprises information concerning the proposal, a customer, experience of the provider with the customer, or experience the provider has had with this or other customers (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 35, Ruffin discloses the computer system of claim 32, wherein the computer program further comprises at least one template of predetermined questions, and the computer program uses the answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses gathering information from a customer via predetermined questions in a profile template.).

As per claim 36, Ruffin discloses the computer system of claim 32, wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses that customers' answers to the predetermined questions can be used to call up additional templates such as financial, work assessment and planning tools.).

As per claim 37, Ruffin discloses the computer system of claim 32, wherein information concerning the customer, the customer's experience with the provider, or the provider's experience with other customers is available in a customer relationship repository of information (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 38, Ruffin discloses the computer system of claim 32, wherein the computer program uses a technique of control-action-response in seeking and inputting information from a user of the computer system (col. 4, lines 49-67; col. 8, line 61-col. 9, line 20; Figure 4; The reference discloses a question and answer engine tool that controls the seeking and inputting of information from a user.).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wright et al. (U.S. 6,581,040) discusses a project communications system where bids of proposals are accessed and evaluated;
- Temple, III et al. (U.S. 6,557,008) discusses a system and method for evaluating aspects of a business enterprise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Thursday from 8:30am to 5:30pm and every other Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Any response to this action should be mailed to:

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703-746-7202 [For status inquiries, draft communication, labeled  
"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA 7<sup>th</sup> floor receptionist.

  
cmc

October 29, 2003

  
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